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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,577	12/05/2003	Scott A. Burton	57260US003	8901
32692 7590 04/09/2010 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
EXAMINER FUBARA, BLESSING M				
ART UNIT		PAPER NUMBER		
1618				
NOTIFICATION DATE		DELIVERY MODE		
04/09/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/728,577	Applicant(s) BURTON ET AL.
Examiner BLESSING M. FUBARA	Art Unit 1618

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 March 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Blessing M. Fubara/
Primary Examiner, Art Unit 1618

Continuation of 11, does NOT place the application in condition for allowance because: The rejection under 35 USC 112, 1st and 2nd are withdrawn in view of applicant's arguments.

The examiner acknowledges applicant's request for reconsideration of the rejection of claims 2-8, 11-19, 21-26, 60, 75-78, 82-84, 88-94, 97-101 and 103-107 over Lorenzi et al. (US 6,217,889). The examiner has carefully considered applicant's arguments but the arguments are not persuasive in view of the following:

The examiner disagrees with applicant's assertion (page 6 of 9 of the remarks) that the examiner ignored the recitation that "at least a portion of the active agent is incorporated within the microparticles" because the recitation that "at least a portion of the active agent is incorporated within the microparticles" is not part of claimed composition but that portion of the claim is part of the process of making the composition. Claims 77 and 82 are product by process claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps and "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). There is therefore no error that claims 77 and 82 are product by process claims. Furthermore, even for the sake of argument, it can be seen as described below, that because the hydrogel particles and the beneficial agent are present together, it flows that at least a portion of the active agent is present in the particles.

However, notwithstanding, the apertured and layered composition (abstract; column 2, lines 31-67; col. 6, lines 18, 60, 61; col. 6, lines 15, 19, col. 7, lines 44-60, 65, 66) has beneficial agent and hydrogel incorporated into one of the layers and hydrogel forming material in the form of particles may be used (col. 18, line 44; column 33, lines 1, 55; column 35, lines 21, 22) such that the combination of particles of hydrogel and beneficial agent would meet the limitation that at least a portion of the active agent is incorporated within the microparticles. Applicant's further argument on page 6 of 9 of the remarks, at paragraphs 4-6, that the silence of Lorenzi on the size of the particles cannot be a proper substitute for an adequate disclosure "of facts from which a conclusion of obviousness may justifiably follow," does not represent a showing that the particles used in the process of making a product provides unusual characteristic to the product since claims 77 and 82 are composition/product claims and Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps and "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The particle size and the %amount of the particles are recited within the process of making the product/composition and because patentability of the composition is not dependent on the method, the silence by Lorenzi on the size of particles does not invalidate Lorenzi as art over the composition. Not with standing, Lorenzi teaches that the hydrogel, which can be in the form of particles (col. 35, lines 21, 22) is present at 0.1-100% or preferably from about 3% to about 50% and most preferably from about 5% to about 35% (col. 33, lines 8-11). The preferred broad range lies within the recited broad range not part of the composition but part of how the composition is made. Since the preferred range in Lorenzi is narrower than the recited broad range, the narrower range of 5% to about 35% of Lorenzi is a species of the broader range of 1-60% and the species (5% to about 35%) anticipates the genus (1-60%). Further, in a case, where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

On page 7 of 9 of the remarks, applicant refers to the examiner's response to applicant's arguments filed 10/23/2009. In response to applicant's argument on page 7 of 9 of the remarks file 3/05/2010, the examiner notes that claims 77 and 82 are product claims recited as product by process; wound dressing is in the preamble and is the intended use of the composition and the composition Lorenzi is capable of the intended use; polyurethane and polyesters are present in dependent claims 8, 12, 94 and 98. And because, the composition of Lorenzi comprises a substrate that further comprises beneficial agents that can be anionic, non-ionic, cationic, amphoteric lathering agents, or therapeutic agents and which further contains hydrogel particles (col. 9, line 44 to col. 33, line 58), it flows that the polymeric composition also comprises polyurethane or polyesters. Furthermore, structured conditioning agent is a beneficial agent and Lorenzi specifically teaches that therapeutic beneficial agents are comprised within "coacervate-forming" composition (column 24, lines 11, 17-26) and polyurethane is a named polymer for the coacervate-forming composition (col. 25, line 39) such that Lorenzi teaches polyurethane as one of the polymers that can be present in the polymer composition. The comprising language of the claims is open. Applicant has also indicated that the provisional obviousness type double patenting rejection will be addressed upon the indication of allowable subject matter. But, MPEP 804 [R-5] A (I) B (1), states "if a 'provisional' nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn. If 'provisional' ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer. Where there are three applications containing claims that conflict such that an ODP rejection is made in each application based upon the other two, it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. Rather, an appropriate terminal disclaimer

must be filed in at least two of the applications to link all three together. This is because a terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed; it is not effective to link the other two applications to each other.*

In the instant case, the rejection will continue to be made and is maintained here because the ODP rejection is not the only rejection left outstanding in the claimed invention..

/BF/